

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-13 are pending in this application. Claims 1 and 4 were rejected under 35 U.S.C. § 101. Claims 5-9 were rejected under 35 U.S.C. § 101. Claims 1-13 were rejected under 35 U.S.C. § 103(a) as unpatentable over “Logic Programming with the World-Wide Web” to Loke et al. (herein “Loke”).

Addressing first the rejections of Claims 1-9 under 35 U.S.C. § 101, those rejections are traversed by the present response.

Applicants first note that independent claim 1 is amended by the present response to set forth the practical application of establishing a link between first and second documents. The claim amendments to claim 1 are believed to address the rejections thereto under 35 U.S.C. § 101.

With respect to claims 5-9, applicants note those claims clearly are directed to a “document link generating apparatus”. Applicants are not aware of any requirement that all apparatuses must be tangibly embodied to a computer system, and thus applicants do not believe that the rejection of claims 5-9 under 35 U.S.C. § 101 is proper. An “apparatus” as recited in claim 5 is clearly a statutory class of invention, and thus claims 5-9 are believed to be in full compliance with all requirements under 35 U.S.C. § 101.

Addressing now the rejection under 35 U.S.C. § 103(a) over Loke, that rejection is traversed by the present response.

It is initially noted that independent claim 1 is amended by the present response to clarify features recited therein. Specifically, independent claim 1 now recites the additional operations:

retrieving and determining the second document
satisfying the link establishing condition; and

establishing a link between the first and the second documents based upon the retrieving and determining.

Such a feature is fully supported by the original specification, for example in Figure 3.

Applicants respectfully submit that the features clarified in the claims clearly distinguish over the applied art to Loke.

According to amended independent claim 1 noted above and as recited in independent claims 5 and 10, an “abstract link” describes “a link establishing condition for establishing a document link between the first document of the link source and the second document of the linking destination …”. Utilizing such an “abstract link” as recited in each of independent claims 1, 5, and 10 is believed to clearly distinguish over the applied art to Loke.

Such an “abstract link” as recited in claims 1, 5, and 10 differs from a conventional link. The claimed invention provides the benefit of decreasing the labor of a description of a link by employing an “abstract link” having less information than that of a conventional link.

Applicants respectfully submit that Loke neither teaches nor suggests utilizing such an “abstract link” describing “a link establishing condition for establishing a document link between the first document of the link source and the second document of the linking destination”, as positively recited in independent claims 1, 5, and 10

Even more particularly, Loke is directed to a device known as LogicWeb that enables programmable behavior and state to be incorporated into web pages, allowing the web pages to be viewed as modules or objects with state.¹ Loke at most discloses a URL, a pointer, and more complex parsing but does not disclose or suggest any type of “abstract link”.

The Office Action even appears to recognize deficiencies in Loke with respect to that claimed subject matter, and the applicants respectfully submit the Office Action has not properly considered those deficiencies.

More specifically, the Office Action states:

¹ Loke, Abstract.

Loke et al. do not explicitly teach that the abstract link describing a link establishing condition for determining a document link between the first document of the link source and the second document of the linking destination on a basis of retrieval of document information of the first document of the link source and the second document of the linking destination; however, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that the link does establish a condition for determining a link ..., since the link establishes a relationship between the page containing it and the page whose URL is an argument of the fact (page 8, third blocked paragraph, last bullet).²

The above-noted grounds for rejection is believed to be improper as it does not properly consider the claim limitations and does not properly establish a *prima facie* case of obviousness. First, applicants note that Loke simply does not teach or suggest any concept similar to the “abstract link” recited in the claims. Applicants also note it is not at all conventional for a link to describe a link establishing condition for establishing a document link between a first document of a link source and a second document of a linking destination. There is simply no teaching cited in any reference to teach or suggest such subject matter, and applicants respectfully submit that it is clearly not conventional.

Applicants also note that the outstanding rejection has not properly set forth a *prima facie* case of obviousness.

As noted in M.P.E.P. § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.

² Office Action of January 30, 2004, the sentence bridging pages 3 and 4.

Applicants respectfully submit that none of the three criteria noted above have been established in the outstanding rejection. First no motivation has been set forth in any art to suggest modifying Loke to use an "abstract link" as in the claims. Second there has been no indication as to how utilizing such an "abstract link" would provide any benefit in a device such as in Loke. Finally, no prior art reference, and in particular Loke, teaches or suggests the feature of the "abstract link".

Thus, the outstanding rejection is believed to not establish any proper positions for a proper case of obviousness.

In such ways, claims 1-13 are believed to clearly distinguish over the applied art to Loke.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

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